REMARKS/ARGUMENTS

This is in response to the Office Action mailed on December 3, 2007. In the Office Action claims 1-21 were rejected under 35 U.S.C. §103(a). Reconsideration of the rejections is respectfully requested in view of the following remarks.

Claims 1-21 are pending in the patent application. No claims have been amended, added or deleted by this response. No new matter has been added by this response.

I)   CLAIM REJECTIONS UNDER 35 U.S.C. §103(a)

In the Office Action, claims 1-21 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. (US 2003/0231605) to Amerga ("Amerga") in view of U.S. Patent No. 6,810,019B2 issued to Steudle ("Steudle").

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, there must be "a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant's disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

Applicant respectfully traverses the above rejections and contends that the burden of establishing a prima facie case of obviousness has not been met for each of the claims 1-21.

Claim 1:

Independent claim 1 reads in part:

An apparatus, comprising:

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.
.

        a frequency controller for generating frequency switch commands, receiving the frequency switch blocking signal, and ***suppressing the generation of frequency switch commands when the frequency switch blocking signal is asserted***. (Emphasis added).

        The Office Action correctly states that Amerga fails to show a frequency controller for generating frequency switch commands, receiving the frequency switch blocking signal, and ***suppressing the generation of frequency switch commands when the frequency switch blocking signal is asserted***, but that this feature is taught by Steudle. (Office Action, page 3). Applicant respectfully disagrees.

        The claimed invention discloses an inter-frequency searching in the presence of frequency gaps in which generation of frequency switch commands are suppressed when a frequency switch blocking signal is asserted. The frequency switch blocking signal is generated by a search scheduler which schedules a search.

        In this regard, it was stated in the Office Action that figure 3; abstract; and col 5, line 44 to col 6, line 19 of Steudle discloses the foregoing features of claim 1 (Office Action, page 3). Applicant has reviewed the cited portions and the entirety of Steudle and has found no mention of the above features of Applicant's invention as claimed in independent claim 1. Steudle discloses a method for defining locations of gaps used for measurements in a time-slot frame, and to define various delays for the measurement patterns of the wireless terminals so that the gaps of the different terminals are in substantially different locations in the time-slot frame. The invention in Steudle is directed to optimizing the distribution of the measurements gaps between various mobile stations so to reduce the interference caused by the mobile stations to each other. (See for example Summary of Steudle).

        Therefore, Steudle does not disclose a frequency controller for … ***suppressing the generation of frequency switch commands when the frequency switch blocking signal is asserted***, as claimed in independent claim 1.

        In this regard it was stated on page 2 of the Office Action that Steudle's feature of using transmission gaps are to be read as a frequency switch blocking signal. Applicant respectfully

disagrees. Gaps, such as those used in W-CDMA, are generally used so that the mobile station may switch frequencies or to make measurements for determining whether switching frequencies should occur. As such, gaps may interfere with intra-frequency searches and other tasks if they occur too frequently. The claimed invention reduces the interference effects of these gaps by suppressing some of the gaps via a frequency switch blocking signal that suppress generation of frequency switch commands during the gaps. This suppression is performed pursuant to a selection as to which gaps are to be suppressed and which are not. Therefore, the frequency switch commands are suppressed pursuant to assertion of a frequency blocking signal, and not by the mere presence or detection of a gap. Therefore, the Applicant respectfully submits that the mere presence of gaps as disclosed in Steudle does not equate to or can be read as a frequency switch blocking signal.

Therefore, Steudle does not disclose a frequency controller for … ***suppressing the generation of frequency switch commands when the frequency switch blocking signal is asserted***, as claimed in independent claim 1.

Thus Amerga and Steudle, taken alone or in any combination, do not disclose, suggest, or render obvious the foregoing features of claim 1. Therefore, Applicant respectfully submits that Amerga and Steudle do not render claim 1 obvious.

Claims 2-12

Dependent claims 2-12 directly or indirectly depend from independent claim 1, and thus include all the limitations of independent claim 1 described previously, as well as reciting additional features. Therefore, for at least the above-stated reasons with regard to independent claim 1, Applicant submits that each of dependent claims 2-12 are patentably distinguished over the cited prior art.

For at least the foregoing reasons, Applicant respectfully requests the withdrawal of the outstanding 35 U.S.C. §103(a) rejections of claims 2-12.

Claim 13:

Independent claim 13 reads in part:

A …. second IC comprising:

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  .
  .

a frequency controller for generating a frequency switch signal comprising frequency switch commands, receiving the frequency switch blocking signal, and ***suppressing the generation of frequency switch commands when the frequency switch blocking signal is asserted***. (Emphasis added).

The Office Action correctly states that <u>Amerga</u> fails to show a frequency controller for generating frequency switch commands, receiving the frequency switch blocking signal, and ***suppressing the generation of frequency switch commands when the frequency switch blocking signal is asserted***, but that this feature is taught by <u>Steudle</u>. (Office Action, page 5). Applicant respectfully disagrees for at least the above-stated reasons with regard to independent claim 1.

Applicant respectfully traverses the 35 U.S.C. §103(a) rejection and requests that claim 13 be allowed.

Claim 14:

Independent claim 14 reads in part:

a processor for

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suppressing the generation of frequency switch commands when the frequency switch blocking signal is asserted.

The Office Action correctly states that <u>Amerga</u> fails to show a frequency controller for generating frequency switch commands, receiving the frequency switch blocking signal, and ***suppressing the generation of frequency switch commands when the frequency switch blocking signal is asserted***, but that this feature is taught by <u>Steudle</u>. (Office Action, page 5). Applicant respectfully disagrees for at least the above-stated reasons with regard to independent claim 1.

Applicant respectfully traverse the 35 U.S.C. §103(a) rejection and requests that claim 14 be allowed.

Claims 15 and 16

Dependent claims 15 and 16 directly depend from independent claim 14, and thus include all the limitations of independent claim 17 described previously, as well as reciting additional features.

Therefore, for at least the above-stated reasons with regard to independent claim 14 Applicant submits that each of dependent claims 15 and 16 are patentably distinguished over the cited prior art.

For at least the foregoing reasons, Applicant respectfully requests the withdrawal of the outstanding 35 U.S.C. §103(a) rejections of claims 15 and 16.

Claim 17:

Independent claim 17 reads in part:

A method of searching in the presence of frequency gaps, comprising:

> .
> .
> .

> ***suppressing frequency switches during the scheduled search.***

The Office Action correctly states that <u>Amerga</u> fails to show ***suppressing frequency switches during the scheduled search*** but that this feature is taught by <u>Steudle</u>. (Office Action, page 6). Applicant respectfully disagrees for at least the above-stated reasons with regard to independent claim 1.

Applicant respectfully traverse the 35 U.S.C. §103(a) rejection and requests that claim 17 be allowed.

Claims 18 and 19

Dependent claims 18 and 19 directly or indirectly depend from independent claim 17, and thus include all the limitations of independent claim 17 described previously, as well as reciting additional features. Therefore, for at least the above-stated reasons with regard to independent claim 17 Applicant submits that each of dependent claims 18 and 19 are patentably distinguished over the cited prior art.

For at least the foregoing reasons, Applicant respectfully requests the withdrawal of the outstanding 35 U.S.C. §103(a) rejections of claims 18 and 19.

Claim 20:

Independent claim 20 is directed to a means for performing the method claimed in claim 17. Therefore, for at least the reasons described above in conjunction with claim 17 Applicant submit that claim 20 is patentably distinguished over the cited prior art.

Applicant respectfully traverse the 35 U.S.C. §103(a) rejection and requests that claim 20 be allowed.

Claim 21:

Amended independent claim 21 is directed to a processor readable media encoded with software operable to perform the method claimed in claim 17. Therefore, for at least the reasons described above in conjunction with claim 17 Applicant submits that claim 21 is patentably distinguished over the cited prior art.

Applicant respectfully traverse the 35 U.S.C. §103(a) rejection and requests that claim 21 be allowed.

CONCLUSION

In light of the amendments contained herein, Applicants submit that the application is in condition for allowance, for which early action is requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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